



IN THE UNITED STATES PATENT OFFICE

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Application Serial No. 07/838,675

Our Ref. : PT-1039 GROUP 150

Applicants : Rudolf Edgar Falk, and  
Samuel Simon Asculai

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Valley, Drive West,  
Thornhill, Ontario.  
L3T 7P6

Title : TREATMENT OF DISEASE EMPLOYING  
HYALURONIC ACID AND NSAIDS

Inventors : Rudolf Edgar Falk, and  
Samuel Simon Asculai

Filed : February 21, 1992

Examiner : Nathan M. Nutter

Group Art Unit: 1503

Due Date: March 13, 1993

9/Election,  
Priority Papers  
& Drawings.  
(3 sheets)

Ret  
3-30-93

March 5, 1993

The Commissioner of Patents,  
UNITED STATES PATENT OFFICE,  
Washington, D.C. 20231  
U.S.A.

Dear Sir:

In response to the outstanding Official Action dated October 13, 1992 due for response November 13, 1992, Applicants enclose a request for a four month Extension of Time to respond to the outstanding Official Action, and the extension fee of \$1,320.00 U.S. The date for filing this response is therefor extended from November 13, 1992 to March 13, 1993. As March 13, 1993 falls on a Saturday, the Response is due on Monday, March 15, 1993.

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With respect to the suggestion by Examiner Nutter that Applicants make this application a Continuation-In-Part to Application

Serial Number 675,908, filed May 20, 1991 in the United States and which U.S. Application is the Application for entering the National Phase from PCT Application Serial Number PCT/CA 90/00306, filed September 18, 1990 and which PCT Application claimed priority from Canadian Application Serial Number 612,307, filed September 21, 1989. Applicants in the enclosed Voluntary Amendment have made this application a continuation-in-part application and enclose the appropriate documentation executed by Doctors Falk and Asculai to support the claim for a continuation-in-part application.

Applicants enclose a certified copy of Canadian Patent Application Serial Number 2,061,566 from which Applicants have claimed priority.

In the Voluntary Amendment, Applicants have amended the claims so that the composition and transdermal delivery claims are now Claim 1 - 5, 16 - 20 and 21 -25. The method of use claims are now Claims 6 - 15. Therefore, Applicants assume that the Examiner will conclude that Claims 1 - 5 and Claims 16 - 25 will be Group I, and Claims 6 - 15 will remain in Group II.

Applicants provisionally elect to proceed with the examination of the Group II claims the method claims (Claims 6-15). Applicants however respectfully traverse the Examiner's conclusions as to why the inventions of Group I and Group II are distinct because the product can be used in a materially different process such as the application of cosmetics. In particular, each of Applicants' claims are limited to the use of a drug (a medicine). No one claim does not contain a drug. Cosmetics do not normally contain a drug; they may be adapted to

contain a drug. In that case the cosmetics would have become a medicated cosmetic or in other words a "medicine". Thus, the comments that "in the instant case the product as claimed can be used in the materially different process such as in application of cosmetics as shown by U.S. Patent 4,851,521 to della Valle et al" is not conclusive. The cosmetic is not a cosmetic per se. It is a medicine able to provide cosmetic benefits. The use of Applicants' invention in a cosmetic would still not change its character for the treatment of disease and/or conditions.

Applicants have brought Application Serial Number 07/838,674 to the Examiner's attention and the Examiner is aware of the election requirement made by Examiner Peselev. Applicants have in response filed in that application respectfully traversed the requirement for the election. However, Examiner Peselev has not sought the same restriction requirement as Examiner Nutter with respect to this application. (While the subject material is different, there are similarities (both have the same parent application) and include composition and method claims.) Therefore evidence that Groups I and II are not separate inventions and should not be separately examined exists in the Patent Office particularly in the prosecution of Application Serial Number 07/838,674. Both composition and method claims will be examined in Application Serial Number 07/838,674 - a species election was sought and Applicants respectfully submit, traversed. No finding in that application was made that the composition and method claims were distinct inventions.

In view of the above, Applicants respectfully submit that Applicants have traversed the conclusions of the Examiner and

respectfully submit that examination should proceed for both Groups I and II. However, if the Examiner is not satisfied with Applicants' submissions, then Applicants elect Group II for the purposes of examination.

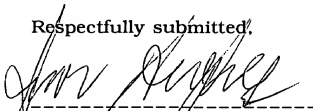
With respect to the drawings, Applicants enclose revised drawings as required. Applicants believe that the drawings as submitted overcome the objections raised.

Examiner Nutter is thanked for all of his efforts with respect to this application and Application Serial No. 07/838,674, and in assisting Applicants to determine the status of parent Application Serial No. 07/675,908 which had not been examined before this application. That application has now been acted upon by the Patent Office.

Applicants also enclose an Information Disclosure Statement, together with the appropriate fee of \$200.00 dollars with respect to the filing thereof including the prior art identified in the Information Disclosure Statement.

If the Examiner wishes to discuss any matter in respect of this application, Examiner Nutter is respectfully requested to contact Ivor M. Hughes at 1-800-265-6836.

Respectfully submitted,

  
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IVOR M. HUGHES  
Agent for the Applicants.  
Registration No. 27,759

IMH/mrg

Enclosures